

REMARKS

Initially, Applicant would like to express his appreciation to the Examiner, Mr. William H. Mayo, for the courtesy of the interview conducted with his attorney Ms. Linda J. Hodge, on September 10, 2003. During the interview, the claims were discussed and compared to the prior art applied by the Examiner in the rejections, *i.e.*, SATO et al. (U.S. Patent No. 5,133,677); SATO et al. (U.S. Patent No. 5,171,166); and YAMAGUCHI (U.S. Patent No. 5,975,950). It was agreed that the present invention defined in claim 12 patentably distinguishes over SATO et al. '677, and the Examiner agreed to withdraw the rejection of claim 12 under 35 U.S.C. § 102(b) over SATO et al. '677. No agreement was reached regarding remaining claims 1-11 and 13-22.

Applicant would also like to express appreciation to the Examiner for the detailed Official Action provided and for the acknowledgment of Applicant's Claim for Priority and receipt of the certified copy of the priority document. However, Applicant notes that the Examiner has not indicated that the drawings have been approved by the Official Draftsperson on a Form PTO-948. The Examiner is thus requested to indicate that Applicant's drawings are acceptable in the next Official Action.

Additionally, Applicant notes that the Form PTO 1449 returned with the Office Action dated December 16, 2002 did not have the Examiner's initials adjacent the English language

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the translation column on the Form PTO 1449 opposite the Japanese document. Thus, it is presumed that the Examiner considered the English language abstract when considering the underlying document.

Further, Applicant notes that the YAMAGUCHI patent, which was discussed during the interview and applied in the Official Action, has not been cited on a Form PTO 1449. Accordingly, the Examiner is respectfully requested to cite the YAMAGUCHI patent on a Form PTO 1449 along with the next Official communication.

Upon entry of the above amendment, claims 1, 12, and 22 will have been amended. Accordingly, claims 1-22 are currently pending. Applicant respectfully requests reconsideration of the outstanding rejections and allowance of claims 1-22 in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

The Examiner has rejected claims 1, 4, 5, 7-13, 15, and 17-21 under 35 U.S.C. § 102(b) as being anticipated by SATO et al. (U.S. Patent No. 5,133,677). The Examiner takes the position that the SATO et al. patent discloses a shielded connector assembly and a method for assembling a female shielded terminal including an internal terminal 5 connectable to an inner conductor 24 and a dielectric 4 mounted on the outer periphery of the internal terminal.

Although Applicant does not necessarily agree with the Examiner's rejection of the claims on this ground, nevertheless, Applicant has amended independent claims 1 and 12 to clearly obviate the above noted ground of rejection in order to expedite prosecution of the present application. In this regard, Applicant notes that SATO et al. fails to show each and every element recited in the amended claims. In particular, claim 1, as amended, recites a female shielded terminal including, inter alia, "an internal terminal configured to be connectable to an inner conductor of a shielded electric wire, said internal terminal including at least one elastic connecting piece to contact a corresponding male terminal, said internal terminal remaining unconnected to a shielded electric wire, said internal terminal connected to a carrier; and a dielectric mounted on an outer periphery of said internal terminal". Claim 12, as amended, recites a method of assembling a female shielded terminal including, inter alia, "providing an internal terminal to connect to an inner conductor of a shielded electric wire, said internal terminal including at least one elastic connecting piece to contact a corresponding male terminal, said internal terminal connected to a carrier; mounting a dielectric on an outer periphery of said internal terminal, while said internal terminal remains connected to said carrier". It is respectfully submitted that no new matter has been added in the present amendment. In this regard, support for the present amendment can be found at least in the specification in paragraphs [0027] and [0033]-[0034] and in figures 2 and 8. As

connecting the internal terminal 5 to the inner conductor 24 *before* mounting the dielectric 4 on the internal terminal 5 and inner conductor 24 combination. See particularly figure 9 (the arrow shows the direction of movement of the internal terminal 5 and inner conductor 24 combination into the dielectric 4) and column 2, lines 59-64 and column 3, lines 3-5. Therefore, as agreed during the interview, the SATO et al. patent fails to disclose a method of assembling a female shielded terminal including mounting a dielectric on the internal terminal, and after mounting the dielectric on the internal terminal, connecting the inner conductor to the internal terminal. Additionally, SATO et al. '677 fails to show providing the internal terminal linked to adjacent internal terminals and connected to a carrier, and inserting the internal terminal into the dielectric while the internal terminal is still connected to the carrier. At no point, during or after the assembly of the SATO et al. '677 device, is an assembly provided in which the dielectric is mounted on the outer periphery of the internal terminal and the internal terminal remains unconnected to the inner conductor of the shielded electric wire, as recited in independent claim 1. It is noted that in the present invention, further processing steps (e.g., mounting an external terminal on the dielectric, and then connecting the external terminal to the outer conductor) are performed on the internal terminal and inner conductor combination with the dielectric mounted thereon, to form a final product, which also fails to include a dielectric mounted on the outer periphery of the

the shielded electric wire. Therefore, the SATO et al. '677 patent fails to disclose an assembly for a female shielded terminal including, inter alia, "an internal terminal configured to be connectable to an inner conductor of a shielded electric wire, said internal terminal including at least one elastic connecting piece to contact a corresponding male terminal, said internal terminal remaining unconnected to a shielded electric wire, said internal terminal connected to a carrier; and a dielectric mounted on an outer periphery of said internal terminal " as set forth in claim amended 1. Additionally, the SATO et al. '677 patent fails to disclose a method of assembling a female shielded terminal including, inter alia, "providing an internal terminal to connect to an inner conductor of a shielded electric wire, said internal terminal including at least one elastic connecting piece to contact a corresponding male terminal, said internal terminal connected to a carrier; mounting a dielectric on an outer periphery of said internal terminal, while said internal terminal remains connected to said carrier" as set forth in claim amended 12. Since the reference fails to show each and every element of the claimed device and method, the rejection of claims 1 and 12 under 35 U.S.C. § 102(b) over SATO et al. '677 is improper and withdrawal thereof is respectfully requested.

Applicant submits that dependent claims 4, 5, 7-11, 13, 15, and 17-21, which are at least patentable due to their dependency from claims 1 and 12 for the reasons noted above,

recite additional features of the invention and are also separately patentable over the prior art of record based on the additionally recited features.

The Examiner has rejected claims 2, 3, and 14 under 35 U.S.C. § 103(a) over SATO et al. '677 in view of SEKO et al. (U.S. Patent No. 5,951,336). It is presumed that the Examiner intended that claims 2, 3, and 14 should be rejected over SATO et al. '677 in view of SEKO et al., since while the Official Action states on page 6 that claims 2, 3, and 14 are rejected "over SATO (Pat Num 6,210,223)", this is apparently a typographical error since the references to the figures, the specification, and the reference numerals appear to correspond to SATO et al. (U.S. Patent No. 5,133,677) and since claims 1 and 12, on which claims 2, 3, 14 depend, were rejected over SATO et al. '677.

Applicant notes that SATO et al. fails to teach or suggest the subject matter claimed, including, inter alia, "an internal terminal configured to be connectable to an inner conductor of a shielded electric wire, said internal terminal including at least one elastic connecting piece to contact a corresponding male terminal, said internal terminal remaining unconnected to a shielded electric wire, said internal terminal connected to a carrier; and a dielectric mounted on an outer periphery of said internal terminal" as set forth in amended independent claim 1 as described above; and a method of assembling a female shielded terminal including, inter alia, "providing an internal terminal to connect to an inner conductor of a

to contact a corresponding male terminal, said internal terminal connected to a carrier; mounting a dielectric on an outer periphery of said internal terminal, while said internal terminal remains connected to said carrier”, as set forth in amended independent claim 12, as described above. Further, SEKO et al. fails to cure these deficiencies. Moreover, there is nothing in the cited prior art that would lead one of ordinary skill in the art to make the modification suggested by the Examiner in the rejection of claims 2, 3, and 14 under 35 U.S.C. § 103(a) over SATO et al. ‘677 in view of SEKO et al. Thus, the only reason to combine the teachings of SATO et al. ‘677 and SEKO et al. results from a review of Applicant’s disclosure and the application of impermissible hindsight. Even if the teachings of SATO et al. ‘677 and SEKO et al. were combined, as suggested by the Examiner, the claimed combination would not result. Accordingly, the rejection of claims 2, 3, and 14 under 35 U.S.C. § 103(a) over SATO et al. ‘677 in view of SEKO et al. is improper for all the above reasons and withdrawal thereof is respectfully requested.

The Examiner has rejected claims 6 and 16 under 35 U.S.C. § 103(a) over SATO et al. ‘677 in view of YAMAGUCHI (U.S. Patent No. 5,975,950). For the same reasons as explained above, it is presumed that the Examiner intended that the claims should be rejected over SATO et al. ‘677 in view of YAMAGUCHI. Additionally, it is noted that, while in the first sentence of paragraph 5, the Examiner has referred to claims 6 and 17, it is presumed

of YAMAGUCHI, since claim 16 and the subject matter thereof is referred to in the body of paragraph 5.

Applicant notes that SATO et al. fails to teach or suggest the subject matter claimed, including, inter alia, "an internal terminal configured to be connectable to an inner conductor of a shielded electric wire, said internal terminal including at least one elastic connecting piece to contact a corresponding male terminal, said internal terminal remaining unconnected to a shielded electric wire, said internal terminal connected to a carrier; and a dielectric mounted on an outer periphery of said internal terminal" as set forth in amended independent claim 1 as described above; and a method of assembling a female shielded terminal including, inter alia, "providing an internal terminal to connect to an inner conductor of a shielded electric wire, said internal terminal including at least one elastic connecting piece to contact a corresponding male terminal, said internal terminal connected to a carrier; mounting a dielectric on an outer periphery of said internal terminal, while said internal terminal remains connected to said carrier", as set forth in amended independent claim 12, as described above. Further, YAMAGUCHI fails to cure these deficiencies. Moreover, there is nothing in the cited prior art that would lead one of ordinary skill in the art to make the modification suggested by the Examiner in the rejection of claims 6 and 16 under 35 U.S.C. § 103(a) over SATO et al. '677 in view of YAMAGUCHI. Thus, the only reason to combine



disclosure and the application of impermissible hindsight. Even if the teachings of SATO et al. '677 and YAMAGUCHI were combined, as suggested by the Examiner, the claimed combination would not result. Accordingly, the rejection of claims 6 and 16 under 35 U.S.C. § 103(a) over SATO et al. '677 in view of YAMAGUCHI is improper for all the above reasons and withdrawal thereof is respectfully requested.

The Examiner has also rejected claim 22 under 35 U.S.C. § 103(a) as being unpatentable over SATO et al. '677 in view SATO et al. (U.S. Patent No. 5,171,166). The Examiner takes the position that SATO et al. '677 fails to show simultaneously connecting the inner conductor of the shielded cable to the internal terminal and connecting the external terminal to the outer conductor of the shielded electric wire. The Examiner contends that it would have been obvious to one having ordinary skill in the art to modify the method of SATO et al. '677 to comprise the method as taught by SATO et al. '166 to provide good shielding effects and to simplify the automation.

Although Applicant does not necessarily agree with the Examiner's rejection of claim 22 on this ground, nevertheless, Applicant has amended independent claim 22 to clearly obviate the above noted ground of rejection in order to expedite prosecution of the present application. In this regard, Applicant notes that SATO et al. '677 and SATO et al. '166 fail to teach or suggest the subject matter claimed in amended claim 22. In particular, claim 22,

alia, “providing an internal terminal to connect to an inner conductor of a shielded electric wire, said internal terminal including at least one elastic connecting piece to contact a corresponding male terminal, said internal terminal connected to a carrier; mounting a dielectric on an outer periphery of said internal terminal, while said internal terminal remains connected to said carrier”. The SATO et al. ‘677 patent discloses a method including connecting the internal terminal and inner conductor *before* mounting the dielectric on the internal terminal, as shown in figures 9 and 10. The SATO et al. ‘677 method does not include “providing an internal terminal to connect to an inner conductor of a shielded electric wire, said internal terminal including at least one elastic connecting piece to contact a corresponding male terminal, said internal terminal connected to a carrier; mounting a dielectric on an outer periphery of said internal terminal, while said internal terminal remains connected to said carrier”, as set forth in amended claim 22. The SATO et al. ‘166 patent fails to cure the deficiencies of the SATO et al. ‘677 method, and even assuming, arguendo, that the teachings of SATO et al. ‘677 and SATO et al. ‘166 have been properly combined, Applicant’s claimed female terminal assembling method would not have resulted from the combined teachings thereof.

Further, there is nothing in the cited prior art that would lead one of ordinary skill in the art to make the modification suggested by the Examiner in the rejection of claim 12 under

to combine the teachings of SATO et al. '677 and SATO et al. '166 results from a review of Applicant's disclosure and the application of impermissible hindsight. Accordingly, the rejection of claim 12 under 35 U.S.C. § 103(a) over SATO et al. '677 in view of SATO et al. '166 is improper for all the above reasons and withdrawal thereof is respectfully requested.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of all the rejections, and an early indication of the allowance of claims 1-22.

#### SUMMARY AND CONCLUSION

In view of the foregoing, it is submitted that the present amendment is proper and that none of the references of record, considered alone or in any proper combination thereof, anticipate or render obvious Applicant's invention as recited in claims 1-22. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Accordingly, consideration of the present amendment, reconsideration of the outstanding Official Action, and allowance of the present amendment and all of the claims therein are respectfully requested and now believed to be appropriate.

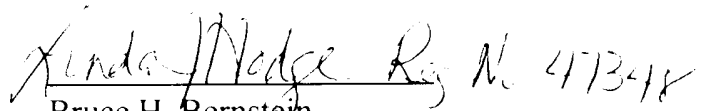
Applicant has made a sincere effort to place the present application in condition for allowance and believe that they have now done so.

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Applicant notes that this amendment is being made to advance prosecution of the application to allowance, and should not be considered as surrendering equivalents of the territory between the claims prior to the present amendment and the amended claims.

Should there be any questions, the Examiner is invited to contact the undersigned at the below listed number.

Respectfully submitted,  
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